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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,942	07/24/2003	Matthew Banet	0307091.0166	9891
35602	7590	03/16/2005	EXAMINER	
STEPHEN C. GLAZIER KIRKPATRICK & LOCKHART LLP 1800 MASSACHUSETTS AVENUE, NW WASHINGTON, DC 20036			ISSING, GREGORY C	
			ART UNIT	PAPER NUMBER
			3662	

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No.	Applicant(s)	
	10/625,942	BANET ET AL.	
	Examiner	Art Unit	
	Gregory C. Issing	3662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 56-58 and 61-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56, 59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3 IDS's (see OA)</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election without traverse of Group I, claims 1-55, 59 and 60 in the reply filed on 12/16/04 is acknowledged.
2. The IDS's filed 2/3/05 (1 sheet), 8/24/04 (4 sheets), and 9/17/03 (3 sheets) have been considered by the Examiner.
3. Applicant has petitioned the application to be made special which petition as been accepted. Applicant in their petition to make special fulfilled their obligation of citing the most material prior art as well as defining the distinction over the prior art. It is noted that the purpose of an IDS, and particularly in an application to be made special, is to provide the most material prior art references. However, it is noted that the applicants have cited seven pages of cited prior art, with statements with respect to only three references, without any statements with respect to the remaining, as well as setting forth duplicative prior art references, either via application number/patent number or associated related applications having substantially identical specifications. Furthermore, the applicants' statement of distinction over the prior art includes the statement of the failure of the prior art to show "an internal battery that includes a solar cell." As this is not present in any of the independent claims and, in fact, is only in a single dependent claim (claim 16), it is not clear how this represents a truthful statement of the alleged distinction and apparent novelty of the claimed device over the prior art.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-15, 17-55, 59 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al (6,526,335).

6. Treyz et al disclose a vehicle computer system (Figure 2) coupled to vehicle electronics (Figure 3). The vehicle computer system includes a position detection module in the form of a GPS receiver, a plurality of communication transmitters in the form of a terrestrial antenna and a satellite antenna, a microprocessor and DSP for controlling the operation. The vehicle electronics system includes various sensors and controls and is coupled to the vehicle computer system to provide transmission via various formats.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-55, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unnold (2004/0196182) 102 in view of Bouliane (CA 2,133,673).

9. Unnold disclose an intelligent mobile management device including an internal battery 106 having a solar cell 104, a GPS module 108, a satellite transmitter 110, a terrestrial transmitter 112, and a processor 114. The rechargeable battery provides adequate power to supply all of the above noted equipment and since the solar cells provide continuous charging there is no need to replace under normal circumstances. Though Unnold discloses using both a terrestrial and satellite transmitter, the selection based on coverage is not specified.

10. Bouliane disclose a vehicle signal transmission system including a GPS module, a first wireless transmitter 52/53 operating on a terrestrial network, a second wireless transmitter 54/55 operating on a satellite network, (a third wireless transmitter 24a), and a system controller 49

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coupled via a system data bus 42 to a plurality of system components that selects, based on coverage range, the first or second transmitter to communicate position and alarm conditions from the mobile vehicle to a remote central base station.

11. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Unnold by incorporating the microprocessor control to selectively switch the transmitter on the basis of the coverage associated therewith in view of the teachings of Bouliane so as to provide a world-wide capability of communication using both terrestrial and satellite communication networks.

12. Claims 1-55, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisshaar et al (2003/0130005) in view of Chou (2002/0177476), Welles, II et al (5,491,486) or Kennedy, III et al (6,240,295).

13. Weisshaar et al disclose the subject matter substantially as claimed but fails to show an internal battery that includes a solar cell, see Applicants' Discussion of the References, page 2. Each of Chou, Welles, II et al and Kennedy, III et al teach the conventionality of using a solar panel to charge a battery in a mobile communication device.

14. Chou discloses a durable global asset tracking device including a location module 12 in the form of GPS, e.g., a communication module 14 that comprise a terrestrial transmitter/receiver, a satellite transmitter/receiver, and a control circuit for evaluating the validity of communications and provide selective switching in response thereto, a power module 16 comprises a high energy-density battery with a solar recharging source, an antenna module 18 comprising the various antennas, and a processor module 20 for coupling and controlling the various components so as to communicate position to a remote tracking facility.

15. Welles, II et al teach a mobile tracking device wherein the mobile tracking device including a GPS module 50, a microprocessor 58, a wireless communicator 52, a vehicle communication unit

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56/68 for collecting diagnostic information, and communicating it to the microprocessor and further includes an internal battery 62 that is charged via an array of solar cells 66.

16. Kennedy, III et al disclose a communication device on a mobile asset including a processor 44 coupled to a positioning module 58, sensors such as monitors, status and diagnostic modules, a battery 56 that may be recharged using a solar cell 70 wherein the communication device bi-directionally communicates with a base station to communicate voice and data messages wherein the messages may include position as well as diagnostic information.

17. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Weisshaar et al by utilizing a solar panel to provide continuous charging capabilities for the battery powering the vehicle computer/communication device in view of the advantages of solar panels as taught by each of Chou, Welles, II et al or Kennedy, III et al.

18. Claims 1-55, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou (2002/0177476) in view of Nathanson (2002/0150050).

19. Chou discloses a durable global asset tracking device including a location module 12 in the form of GPS, e.g., a communication module 14 that comprise a terrestrial transmitter/receiver, a satellite transmitter/receiver, and a control circuit for evaluating the validity of communications and provide selective switching in response thereto, a power module 16 comprises a high energy-density battery with a solar recharging source, an antenna module 18 comprising the various antennas, and a processor module 20 for coupling and controlling the various components so as to communicate position to a remote tracking facility. Chou fails to disclose collection of vehicle diagnostics.

20. Nathanson discloses a system and method which implements an Internet-based protocol stack for vehicular diagnostic telemetry wherein it should be possible for OBD-III compliance to be met using a variety of wireless data link technologies including packet cellular, RF packet networks, wireless LAN, satellite or any combination thereof. GPS position included in message.

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21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chou by incorporating the asset tracking device on a vehicle wherein the vehicle includes OBD such that the information associated therewith may be telemetered to a remote tracking station so as to monitor the safety of the mobile asset in view of the teachings of Nathanson.

22. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (6,526,335) in view of Kennedy, III et al, Chou or Welles, II et al.

23. Treyz et al teach the subject matter substantially as claimed as set forth above but fails to show the use of solar panels to charge the internal battery. Each of Chou, Welles, II et al and Kennedy, III et al teach the conventionality of using a solar panel to charge a battery in a mobile communication device as set forth above.

24. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Treyz et al by utilizing a solar panel to provide continuous charging capabilities for the battery powering the vehicle computer/communication device in view of the advantages of solar panels as taught by each of Chou, Welles, II et al or Kennedy, III et al.

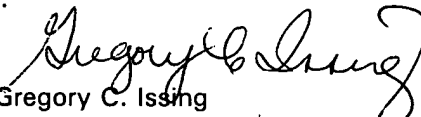
25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Caci (6,154,658) disclose a vehicle information and safety control system including a plurality of on board diagnostic sensors and safety sensors 20/24, a position detection module in the form of a GPS receiver 14, a processor 12 and a plurality of wireless communication transmitters for transmitting diagnostic information tagged with position from the mobile vehicle to a remote tracking facility.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is 703-306-4156. As of April 4, 2005, the new number will be 571-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on 703-306-4171 (new 571-272-6979). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci